

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1248-0674P	
		Application Number 10/681,167-Conf. #6469	Filed October 9, 2003
		First Named Inventor Yasuaki FUKADA et al.	
		Art Unit 2854	Examiner A. H. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)

attorney or agent of record.

Registration number 19,382



Signature

HSB 3/17

 Terrell C. Birch

Typed or printed name

attorney or agent acting under 37 CFR 1.34.

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April 9, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

The Examiner has made clear errors in interpreting and applying the appropriate tests and applying the prior art in rejecting claims 1-3, 6-12 and 17 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Noguchi et al. (USP 4,978,980); and rejecting claims 4-5 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Noguchi et al. in view Yasui et al. (USP 5,839,032).

The Examiner has Failed to Establish *Prima Facie* Anticipation or, in the Alternative, *Prima Facie* Obviousness, by Failing to Provide References that Teach or Suggest All of the Elements of Claim 1

The Examiner has made clear error in considering certain claim elements are explicitly or inherently taught by the teachings of Noguchi et al. With regard to claim 1, the Examiner asserts that Noguchi et al. teaches, either explicitly or inherently, all of the elements as set forth in the claim. Applicants maintain that claim 1 is not anticipated by, or unpatentable over, the teachings of Noguchi et al.

In support of the Examiner's rejection of claim 1, the Examiner refers to Figs. 21-28 to support his rejection. The Examiner admits that Noguchi et al. fails to explicitly teach "the intermediate roller which is in synchronism with a resumption of rotation of the resist roller." The Examiner, however, asserts that the use of the intermediate roller which is synchronized with the resumption of rotation of the resist roller is necessary to provide an operative two-side image forming apparatus or a paper jam would occur. Applicants respectfully disagree with the Examiner's assertions.

Noguchi et al. discloses a control method for a both-surface/multiplex recording apparatus. In col. 8, line 41 through col. 9, line 24, the entire disclosure of Figs. 21-28 are described. As can be seen at this citation, Noguchi et al. discloses that the characteristics of the two-side image forming apparatus are that, in order to improve the throughput, two types of transferring speeds, or conveyance velocities, are provided. The recording medium moves through the recording apparatus based on control of the conveyance velocity.

The Examiner alleges that roller 504 (Figs. 21 to 28) described in Noguchi et al. corresponds to the resist roller of the present invention. However, Noguchi et al. does not provide any explanation of roller 504. Further, Noguchi et al. does not describe any **resumption**

of the rotation of the resist roller. Noguchi discloses improving throughput by providing two transferring speeds, not by synchronizing the resumption of rotation of rollers.

Further, the Examiner asserts that the “register roller” must be in synchronism with the intermediate roller. However, the register rollers are only discussed with regard to the prior art device depicted in Figs. 4 and 5. The Examiner relies on the device disclosed in at least Fig. 21 to support his rejection. The register rollers appear to regulate the timing of the transfer of a sheet, from either the paper tray or the from the second sheet transferring path, onto the first sheet transferring path. There is no discussion in these figures that is directed to an intermediate roller along the second sheet transferring path.

Further, there is no disclosure in Noguchi that is directed to rollers 404 or 504. The control of the paper through the device is controlled by the forward and reverse conveying means and adjusting the velocity of the transfer of the recording mediums. There is no disclosure that is directed to the controller controlling a rotation of the intermediate roller being in synchronism with a resumption of rotation of the resist roller.

Noguchi et al. Fails to Inherently Teach or Suggest the Missing Claim Element

The Examiner asserts that it must be inherent in Noguchi et al. that the rotation of the intermediate roller is in synchronism with rotation of the resist roller or else a paper jam would occur. Applicants respectfully disagree with this assertion.

It is respectfully submitted that the court in *In re Robertson* held “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Noguchi et al. clearly discloses that the recording medium’s movement through the recording apparatus is controlled by adjusting the conveyance velocity. Noguchi discloses improving throughput by providing two transferring speeds, not by controlling resumption of rotation of rollers in synchronism with other rollers. As such, it is not necessarily the case that Noguchi et al. must control resumption of rotation of rollers in synchronism with other rollers. Further it is not necessarily the case that Noguchi et al. must control resumption of rotation of

rollers in synchronism with other rollers in order to avoid a paper jam. Noguchi et al. clearly discloses providing two transferring speeds to avoid jams. As such, Applicants maintain that Noguchi et al. does not inherently teach this claim element.

Noguchi et al. Teaches Away from the Purported Inherent Feature

The Examiner alleges that roller 504 (Figs. 21 to 28) described in Noguchi et al. corresponds to the resist roller of the present invention. However, Noguchi et al. does not provide **any** explanation of roller 504. Further, Noguchi et al. does not describe any **resumption** of the rotation of the resist roller. Noguchi discloses improving throughput by providing two transferring speeds, not by synchronizing the resumption of rotation of rollers. In fact, Noguchi performs the recording continuously to keep the throughput highest. As such, not only does Noguchi et al. fail to teach this claim element, Noguchi et al. teaches away from stopping the rotation temporally in order to resume rotation of the resist roller, as this would reduce throughput.

Examiner's Assertion of Inherency Results in an Inoperable Device

The Examiner asserts that Noguchi et al. must inherently teach the intermediate roller being in synchronism with a resumption of rotation of the resist roller in order to avoid a paper jam.

It is well established that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

If, in fact, the resist roller 504 and the intermediate roller 515 are in synchronism with each other a jam may occur at the crossing point of the paths 509 and 508 to roller 504.

As such, Applicants respectfully submit that it is not inherent that Noguchi et al. teaches this claim element. If the Examiner's interpretation were true, the device would be inoperable as a paper jam would occur.

Noguchi et al.'s Disclosure Fails to Enable the Examiner's Interpretation

In support of the Examiner's rejection, the Examiner presumes certain teachings of Noguchi et al. in order to support his inherency theory.

It is well established that "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. **>Mayo Found. For Med. Educ. & Research<*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Noguchi et al. clearly discloses movement of a recording medium through the recording apparatus by adjusting the conveyance velocity. There is no disclosure in Noguchi et al. that is directed to stopping or resuming rotation of rollers. Moreover, there is no disclosure in Noguchi et al. that is directed to a rotation of the intermediate roller being in synchronism with a resumption of rotation of the resist roller. Noguchi is silent with regard to the control or operation of the purported intermediate roller and the resist roller. As such, one of ordinary skill in the art could not have properly combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention.

Applicants maintain that, based on the description of Noguchi et al. in total, and with regard to Figs. 21 through 28, there is insufficient disclosure, and therefore non-enabling disclosure, to support the Examiner's assertion of an inherent teaching of the controller controlling a rotation of the intermediate roller to be in synchronism with a resumption of rotation of the resist roller.

As there is insufficient enabling disclosure, Applicants maintain that Noguchi et al. fails to teach or suggest, either explicitly or inherently, all of the claim elements and thus claim 1 is not anticipated by, and thus patentable over, Noguchi et al. It is respectfully submitted that the outstanding rejection should be withdrawn.

For all of the reasons set forth above, Applicants maintain that claim 1 is patentable over the reference as cited. It is respectfully requested that the outstanding rejection be withdrawn.

Claims 2-3, 5-8 and 12 are allowable for the reason set forth above with regard to claim 1 at least based on their dependency on claim 1. Claim 17 include elements similar to elements discussed above with regard to claim 1 and this claim, together with claims dependent thereon, is allowable for the reasons set forth above with regard to claim 1.

The Examiner has Failed to Establish *Prima Facie* Obviousness, by Failing to Provide References that Teach or Suggest All of the Elements of Claims 4 and 13

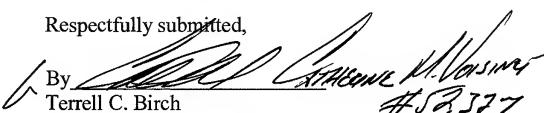
Claims 4 and 13 include elements similar to elements discussed above with regard to claim 1. These claims were rejected under 35 U.S.C. §103(a) as being unpatentable over the teachings of Noguchi et al. and Yasui et al. The Examiner, again, relies on Noguchi et al. to teach the controller controlling a rotation of the intermediate roller being in synchronism with a resumption of rotation of the resist roller. However, for the reasons noted above, Noguchi et al. is wholly insufficient to teach or suggest this claim element. As Yasui et al. fails to cure the deficiencies of the teachings of Noguchi, claims 4 and '14, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: April 9, 2008

Respectfully submitted,

By 

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